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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|--------------------------|---------------------|------------------|
| 10/628,190 | 07/28/2003 | Neil Lawrence Weisenfeld | NW-1 | 6087 |

7590 06/09/2004
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Milford, OH 45150

EXAMINER

REIS, TRAVIS M

ART UNIT PAPER NUMBER

2859

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|---|--|
| Office Action Summary | Application No. 10/628,190 | Applicant(s) WEISENFELD, NEIL LAWRENCE | |
| | Examiner Travis M Reis | Art Unit 2859 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 19, 20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>20030728</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

1. Claim 19 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 15. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 20 is objected to due to its dependence of an objected base claim.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the identifying indicia must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

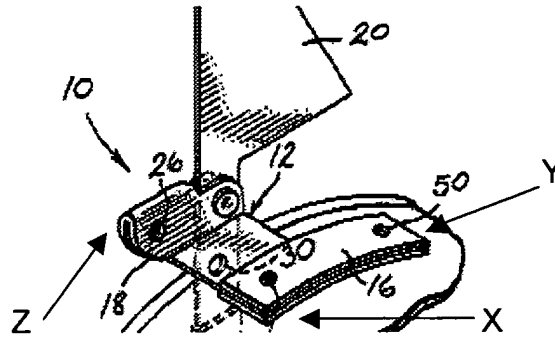
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 7, 10, 11, 13-15 & 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Pieszchala (U.S. Patent 3958752).

Pieszchala discloses a device comprising a substantially U-shaped member (18) comprising on one leg of said U-shaped member the support portion (16) with opposing end

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tabs (X, Y, see below) and on the other leg of said U-shaped member a shield member (Z, see below),



an elongated indicator arm (14) disposed interiorly of said U-shaped member (Figure 3), being rotatably connected to said U-shaped member, said elongated indicator arm being rotatable from a first position to a second position in which said indicator arm is disposed substantially perpendicular to said first position (Figures 3 & 4). Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed (i.e. "being capable of engaging one of the plurality of equally spaced parallel slots" in claim 1; "for use with a hanging folder" in claim 2; "for attaching said support portion to a folder" in claim 7) does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. **Ex parte Masham**, 2 USPQ2d 1647 (1987).

With respect to the preamble of the claims 1-4, 7, 10, 11, 13-15 & 19: the preamble of the claim does not provide enough patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self – contained description of the structure not depending for completeness upon the introductory clause. **Kropa v. Robie**, 88 USPQ 478 (CCPA 1951).

With reference to claims 4, 11, 15, 19, with respect to the term " adapted for ": this term makes what follows a functional statement and not a positive limitation because it has

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been held that the recitation that an element is " adapted for " performing a function only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

In re Hutchinson, 69 USPQ 138.

In this case, Pieszchala discloses the support portion of the device, which could be adapted, if so desired by a user to exhibit identifying indicia as stated in the claims.

5. Claims 7, 9, 11, & 12, are rejected under 35 U.S.C. 102(b) as being anticipated by Edwards (U.S. Patent 2610604).

With reference to claims 7, 9, & 12, Edwards discloses a device comprising a metal support portion (6) (col. 1 line 28); a plastic elongated indicator arm (16) (col. 1 line 48) rotatably connected to said support portion (Figure 2), said elongated indicator arm being rotatable from a first position (19) to a second position (14) in which said indicator arm is disposed substantially perpendicular to said first position; and frictional attachment means (9) for attaching said support portion to a holder (17) near one of said first or second top edges (Figure 4). Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed (i.e. for attaching said support portion to a folder) does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. **Ex parte Masham**, 2 USPQ2d 1647 (1987).

With respect to the preamble of the claims 7, 9, & 12: the preamble of the claim does not provide enough patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self – contained description of the structure not depending for completeness upon the introductory clause. **Kropa v. Robie**, 88 USPQ 478 (CCPA 1951).

With reference to claim 11, with respect to the term " adapted for ": this term makes what follows a functional statement and not a positive limitation because it has been held that

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the recitation that an element is " adapted for " performing a function only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

In this case, Edwards discloses the support portion of the device, which could be adapted, if so desired by a user, to exhibit identifying indicia as stated in the claims.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5, 6, 8, 12, 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pieszchala.

With reference to claims 8 & 18, Pieszchala does not disclose attachment means (50) comprise pressure sensitive adhesive. However, the use of the particular type of attachment means claimed by applicant, i.e., pressure sensitive adhesive, absent any criticality, is considered to be nothing more than the use of one of numerous and well known alternate types of attachment means that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to attach the support portion to the holder as already suggested by Pieszchala. Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to replace the attachment means disclosed by Pieszchala with pressure sensitive adhesive in order to make the device more lightweight.

With reference to claims 5, 6, & 12, 16, & 17, Pieszchala does not disclose the arm or support portion are made of plastic nor that the plastic for said support portion and arm be

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chosen from the group of polyethylene, polypropylene, polystyrene, polyethylene terephthalate, vinyl or blends thereof. However, the particular type of material used to make the arm and support portion, absent any criticality, is only considered to be the use of a "preferred" or "optimum" material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have found obvious to provide using routine experimentation based, among other things, on the intended use of Applicant's apparatus, i.e., suitability for the intended use of Applicant's apparatus, and since the courts have stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious. See In re Leshin, 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to make the arm and support portion disclosed by Pieszchala out of one of these materials in order to make the device lighter and cheaper.

8. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pieszchala as applied to claims 1-4, 7, 10, 11, 13-15 & 19 above, and further in view of Dawson (U.S. Patent 1544818).

Pieszchala discloses all of the instant claimed invention as stated above in the rejection of claims 1-4, 7, 10, 11, 13-15 & 19 but do not disclose clear plastic adapted for receiving paper strips.

Dawson discloses an index tab (3) with a celluloid window (18) showing a paper strip (7) (Figure 1). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the celluloid window and paper strip disclosed by Dawson to the support portion disclosed by Pieszchala in order to protect the arm from the elements while indicating the address.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Teris discloses a directional sign (U.S. Patent 4176485). Brooks discloses a road emergency sign (U.S. Patent 4070775). Gehlsen discloses a signaling device (U.S. Patent 3132628). Best discloses a card for indexing (U.S. Patent 1310468). Cahn discloses an indicator marker for filing cabinets (U.S. Patent 1031321). Pardoe discloses a document file (U.S. Patent 1048577). Lindsay discloses a signal tab (U.S. Patent 1697985). Wright discloses a label holder (U.S. Patent 1481173). Quigley discloses index equipment (U.S. Patent 1314425). Honecker discloses a marker for index cards (U.S. Patent 1193265). Kravik discloses a file (U.S. Patent 709640). Heiland discloses a card index and signal therefore (U.S. Patent 1688965).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis M Reis whose telephone number is (571) 272-2249. The examiner can normally be reached on 8--5 M--F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for all communications.

Travis M Reis
Examiner
Art Unit 2859



Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800

tmr
June 1, 2004